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TRADEMARK OFFICE

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE,

DATE: August 15, 2005

APPLICANT: Toby Wexler

SERIAL NO: 10/824,889 GROUP ART UNIT: 3644

FILED: 4/14/2004 EXAMINER: Kimberly Smith

FOR Animal toe nail covering and method of manufacture

The Honorable Commissioner of Patents & Trademarks
WASHINGTON, D. C. 20231

Sir

In response to Office action Mailed 08/12/2005 regarding an election requirement, Applicant hereby elects claim 1-17 and species ***Liquid Adhesive*** for prosecution in this application with traverse.

Applicant takes exception to the ruling by examiner that applicant is required to make and election of species under 35 USC 1.121as ref. by examiner. Applicant could not find any reference relating such an election. Upon further examination applicant found the reference to such an election under MPEP 1.146

It is anticipated that claim 6 depending from claim 1 is also a "generic claim " for all types of adhesives further defined under the term "an Adhesive element". Therefore, it would seem logical that the " sheath" in claim 1 could further include the genies an "adhesive element" and be further limited by the various types of adhesive and their means of conveyance.

Examiner makes a distinction between clipping the animal's nails and filing the nails as a means for practicing the invention by a materially different process. Applicants totally disagree with examiner on this point. Filing and clipping are obvious equivalents for removing a portion of the animal's nails. Other means for removing a portion of the nail could easily include sawing, grinding, and sanding all of which are certainly equivalent under the statute of equivalence for achieving the purpose of removing a portion of an object.

Use of the term 'clipping" was chosen simply because it's the most common practice for removing a portion of the animal's nails. Examiners implication that the use of such equivalent methods of removal are distinct from each other seeks to establishes as fact that these methods are distinct thus removing applicant's ability to make an argument in court that they are indeed equivalent. Its very doubtful that examiner would allow an application by others based solely on such a distinction. Such a process claim would certainly be rejected under 35 USC 103 as being an obvious equivalent.

If examiner holds the election to be valid in this case a new set of claims would necessarily be required to claim the process for each and every possible means for removing a portion of an object in a subsequent application. Such claims would become monotonous .

Further, by raising this point as a requirement for election, examiner is predetermining equivalence and thus preventing applicant from combining the structure of the animal cap with the application of the novel caps to an animal toe nail as allowed by statute and rules. The rules allow the applicant to claim both product and process for his invention especially when the process is limited to the product claimed. There is simply no legal support in this case that filing the toe nail constitutes a materially different method of use in view of the product limitation in the claim.

It is respectfully request that the restriction requirement be withdrawn and the application be prosecuted intact.

Respectfully submitted,

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Confomation of Faxed Office Action Responce Sent Aug. 15, 2005

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